

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte VINCENT A. REGER

Appeal No. 1998-1552
Application 08/698,982

HEARD: MAY 4, 2000

Before ABRAMS, FRANKFORT and NASE, Administrative Patent Judges.

ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the decision of the examiner finally rejecting claims 23-31, which at that point constituted all of the claims remaining of record in the application. Subsequently, claim 23 was canceled, and claims 24-27 and 29-31 were amended. However, no claims were allowed

Appeal No. 1998-1552
Application 08/698,982

and claims 24-31 are before us on appeal.

The appellant's invention is directed to a method of enlarging a lumen of an artery that is affected by an atheroma. The claims on appeal have been reproduced in an appendix to the Brief.

THE REFERENCES

The references relied upon by the examiner to support the final rejection are:

Fischell et al. (Fischell) 1989	4,886,061	Dec. 12, (filed Feb. 9, 1988)
Reiss 1990	4,966,604	Oct. 30, (filed Jan. 23, 1989)

THE REJECTIONS¹

Claims 24-27 and 29-31 stand rejected under 35 U.S.C. § 103 as being unpatentable over Reiss.

Claim 28 stands rejected under 35 U.S.C. § 103 as being unpatentable over Reiss in view of Fischell.

¹ Rejections of claims 24-31 under 35 U.S.C. § 112, first and second paragraphs, were withdrawn in the Examiner's Answer.

Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejections and the conflicting viewpoints advanced by the examiner and the appellant regarding the rejections, we make reference to the Examiner's Answer (Paper No. 17) and the Appellant's Brief (Paper No. 15).

OPINION

Both rejections are under 35 U.S.C. § 103. The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, ***In re Keller***, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a *prima facie* case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See ***Ex parte Clapp***, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in

the art and not from the appellant's disclosure. See, for example, ***Uniroyal, Inc. v. Rudkin-Wiley Corp.***, 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988).

The claimed invention deals with the problem of the atherosclerotic narrowing of arteries. According to the appellant, the prior art methods of removing atherosclerotic plaque by means of basket knives carried by catheters are improved upon by his method, in which a radial adjustable cutting head is operated beyond the unconstricted diameter of the artery so that it not only removes the plaque from the lumen of the artery, but also removes some of the wall of the artery. This limitation is expressed in independent claim 24 as the steps of "enlarging the radial size of the cutting head beyond that of radial size of the artery"² and "displacing the enlarged cutting head to engage and axially cut both wall tissue and plaque from the artery." Independent claims 29, 30 and 31 recite similar limitations.

² In keeping with the explanation provided in the specification, we interpret "radial size of the artery" to mean the diameter of the artery unconstricted by the plaque.

Claims 24-27 and 29-31 stand rejected as being unpatentable over Reiss, which is directed to an atherectomy cutter. It is the examiner's position that "[t]he radial size of the Reiss cutting head is obviously enlarged beyond that of the radial size of the artery in view of the close sliding fit therebetween," from which he concludes that "[s]ome wall tissue is obviously cut during the Reiss procedure due to the close proximity of the blades relative to the wall tissue" (Answer, page 3). We do not agree. While the Reiss cutting head might be capable of removing wall tissue in addition to plaque, there is no teaching in Reiss for operating it in such a fashion. Nor, in our view, is there a basis from which it can be concluded that the Reiss cutting head inherently performs the appellant's claimed method. From our perspective, Reiss makes it clear that the cutting head removes only the offending tissue. In this regard, we note the following statements: "the cutting device can then be controllably expanded . . . for cutting obstructive tissue from the lumen" (column 2, lines 62-64); "it is desired that some or all of the lesion 18 be cut away by cutting device 10" (column 3, lines 36 and 37); and "the cutting action can be

increased to the radius 60' or any intermediate desired size to efficaciously cut away the unwanted material of lesion 18 as required" (column 5, lines 13-16). Nowhere is there even a hint that the cutting device is intended to remove wall tissue as well as plaque.

It therefore is our conclusion that the teachings of Reiss fail to establish a *prima facie* case of obviousness with regard to the subject matter recited in the independent claims 24, 29, 30 and 31, and we will not sustain this rejection.

Claim 28, which depends from claim 24, stands rejected as being unpatentable over Reiss in view of Fischell, which is cited for its disclosure of utilizing helical cutting blades in a device for removing atheromas. Be that as it may, Fischell fails to alleviate the deficiency in Reiss that was discussed above, and thus the two references considered together fail to establish a *prima facie* case of obviousness with regard to the subject matter of claim 18. We also will not sustain that rejection.

SUMMARY

The rejections are not sustained.

Appeal No. 1998-1552
Application 08/698,982

The decision of the examiner is reversed.

REVERSED

NEAL E. ABRAMS)	
Administrative Patent Judge)	
)	
)	
)	
CHARLES E. FRANKFORT)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
JEFFREY V. NASE)	
Administrative Patent Judge)	

NEA/ki

Appeal No. 1998-1552
Application 08/698,982

Lynn G. Foster
602 East 300 South
Salt Lake City, UT 84102